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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,253	07/28/2003	Lewis B. Aronson	15436.29.1.2	6707
22913	7590	02/24/2005	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			DOAN, JENNIFER	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CT

Office Action Summary	Application No. 10/629,253	Applicant(s) ARONSON ET AL.	
	Examiner Jennifer Doan	Art Unit 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 13-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>021204</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a continuation in part of the application serial number 10/231,395, filed on 08/29/2002, now U.S. Patent 6,703,561, which is a continuation in part of 10/077,067, filed on 02/14/2002, now U.S. Patent 6,586,678.

Applicants' election without traverse of claims 1-12 in the reply filed on November 30, 2004 is acknowledged.

Information Disclosure Statement

1. The prior art documents submitted by applicant in the Information Disclosure Statement filed on 2/12/2004, have all been considered and made of record (note the attached copy of form PTO-1449).

Drawings

2. The drawings, filed on 7/28/2003, are accepted.

Specification

3. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Inventorship

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102((e), f) or (g) prior art under 35 U.S.C. 103(a).

Obvious Type Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7-9 and 12 of copending Application No. 10/748,051 in view of Gilliland et al. (U.S. Patent 6,350,063).

This is a provisional obviousness-type double patenting rejection.

With respect to claims 5 and 6, Aronson et al. substantially disclose the transceiver module of the claimed invention, except for the transmission line being a 25 ohm and/ or 50 ohm transmission line. However, establishing the transmission line being a 25 ohm and/ or 50 ohm is considered to be obvious, because setting the transmission line with these values would beneficially provide a better signal transmission. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the transmission line being a 25 ohm and/ or 50 ohm, since it also has been held that discovering an optimum value of a result effective variable involves only routine skill in the art and it is noted that the applicant does not disclose criticality in the value claimed. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (see MPEP § 2144.05).

With respect to claims 7-9, Aronson et al. substantially disclose the transceiver module of the claimed invention except the transmitter optical subassembly and the receiver optical subassembly are electrically coupled to a module circuit board through a flexible circuit board disposed in the transceiver module casing.

However, Gilliland et al. (figures 1 and 2) disclose the transmitter optical subassembly (60) and the receiver optical subassembly (70) are electrically coupled to a module circuit board (40) through a flexible circuit board disposed in the transceiver module casing (20). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Aronson et al. to have the transmitter optical subassembly and the receiver optical subassembly electrically coupled to a module circuit board through a flexible circuit board disposed in the transceiver module casing (accordance with the teaching of Gilliland et al.) for the purpose of obtaining an optical transceiver module to efficiently perform a function of converting data signals.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yen et al. (U.S. 2002/0136501) and Gilliland et al. (U.S. 2002/0181895) disclose a transceiver module.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Doan whose telephone number is (571) 272-

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2346. The examiner can normally be reached on Monday to Thursday from 6:00 am to 3:30 pm, second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Doan

Patent examiner

February 18, 2005